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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/742,300	12/18/2003	Xiao-Jie Yuan	X-1447 US	5676

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EXAMINER	
KARLSEN, ERNEST F	

ART UNIT	PAPER NUMBER
2829	

DATE MAILED: 11/29/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

H·A

Office Action Summary	Application No.	Applicant(s)	
	10/742,300	YUAN ET AL.	
	Examiner	Art Unit	
	Ernest F. Karlsen	2829	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *07 September 2005*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-22* is/are pending in the application.

4a) Of the above claim(s) *1-15,21 and 22* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *16-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1203 0605*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Applicant's election with traverse of Invention III, claims 16-20, in the reply filed on September 7, 2005 is acknowledged. The traversal is on the ground(s) that classification is the same and that no burden would be imposed by examining all claims. This is not found persuasive because Applicants have not shown that the groups are not patentably distinct. Admission on the record by Applicants that the groups are not patentably distinct will result in rejoinder. Applicants appear to be arguing that same subclass of classification means same invention. If such were carried to its logical conclusion there could only be one patent per subclass and Applicants could be denied a patent on the basis that there is already at least one patent in class 324, subclass 765. With regard to the "no burden" argument, it is noted that each distinct invention beyond one is a burden in that it draws the attention of the Examiner to its own requirements. Examination requires focus to follow search leads and patterns of logic in formulating applications of the prior art to that which is claimed. When the Examiner has to pursue several search patterns of logic simultaneously or serially, added burden is presented. In order to examine several inventions and/or species simultaneously or serially, added effort beyond that necessary for one invention or species must be expended. Where the effort is serial and the jobs are different the added burden is obvious. Digging two equal holes of the same size requires twice the effort of digging one hole. Such is an obvious conclusion. It can be argued that some inventions or species can be examined simultaneously but such is true only if they are not patentably distinct, that is, if that which applies to any one applies to all others. Where inventions or species are patentably distinct each requires separate consideration. As a for instance,

consider a properly restrictable apparatus and method of use of that apparatus where one has details without correspondence in the other. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other constitutes a burden. If the apparatus and method of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. As a second for instance, consider a properly restrictable combination and subcombination where all the details of the subcombination are not necessary for the combination. Finding references anticipating or making obvious one does not necessarily render the other unpatentable. Having to examine the other is a burden. If the combination and subcombination of the above example are not patentably distinct no burden is presented in examining both since if one falls the other falls as well. Admission on the record that the groups are not patentably distinct will result in rejoinder.

The requirement is still deemed proper and is therefore made FINAL.

Claims 1-15, 21 and 22 are withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected inventions and/or species, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on September 7, 2005.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the

applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claims 16-20 are rejected under 35 U.S.C. 102(e) as being anticipated by Corr '374 (herein Corr). With regard to claim 16, Corr shows in Figure 1, a chip 10 having plural ring oscillator test circuits 22, 24, 26 and 28 thereon. The ring oscillator circuits test different properties of the chip, see columns 3-7. Test circuit 22 can serve as a reference as set forth in column 7, lines 6-22 of Corr. IC chips are normally made in a form having plural layers with interconnects in each of the layers and between layers. Any specific circuit formed on the chip would normally have parts in plural layers and there would be interconnects between the layers. The apparatus of Corr has a first embedded test circuit 26 with a first test load, the first test load being whatever is in the loop of the ring oscillator. The second imbedded ring oscillator 22 has no load that is an unknown load and is therefor considered to have no unknown load. See columns 3 and 4. The oscillators are equal except for variations in the elements that make them up. With regard to claim 17, all IC chips have plural layers and test circuit 24 is a third ring oscillator. With regard to claim 18, the purpose of the apparatus of Corr is to test for variations in circuit elements including transistors and variations therein would make them different types. With regard to claim 19, the chip of Corr is considered at some point in its history to have been part of a wafer wherein the wafer was composed of plural chips. Chips are normally not made one at a time. With regard to claim 20, analyzer 90 of Corr is considered to be field programmable and to contain memory elements in an array. Most memory elements are in an array.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Deal et al, Manna et al, Moore and Suzuki et al are cited to show additional plural ring oscillator apparatus for testing integrated circuit chips.

The non-patent literature reference cited on page 2 of the IDS submitted June 17, 2005 has not been considered and has been crossed out on the From 1449 submitted by Applicant because no copy was received

Any inquiry concerning this communication should be directed to Ernest F. Karlsen at telephone number 571-272-1961.

Ernest F. Karlsen

September 25, 2005

ERNEST KARLSEN
PRIMARY EXAMINER